

Application No. 09/173,858

Atty Docket No. OIN 1004-1

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*Recon. Decision 5-21-07 by
Courtney-Blankenship-McDonald*


Brianna Dahlberg

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Bart Alan MELTZER et al.

Application No. 09/173,858 (09/173,858)

Confirmation No. 4734

Filed: 16 October 1998

Title: **Documents for Commerce in Trading
Partner Networks and Interface
Definitions Based on the Documents**

Group Art Unit: 2178

Examiner: HUYNH, Cong Lac T.

CUSTOMER NO. 22470

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**SECOND PETITION UNDER RULE 183 FOR
(1) Second Rehearing with Suggestion for Expanded Panel;
and (2) Oral Argument**

To the Honorable Chief Administrative Judge Fleming:

This is a disfavored petition for a second rehearing. A second rehearing is needed to complete the *de novo* examination that the Panel has undertaken on appeal, necessitated by the weakness of the Examiner's arguments during prosecution and appeal, which the Panel could not and did not adopt.

Alternatively, it is needed to properly remand the case under Rule 41.50(b)(1) for consideration of new evidence submitted with the first rehearing request.

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The decision On Request for Rehearing introduces new grounds for rejection of Rule 131 declarations that the Examiner never argued and that did not appear in the original Decision on Appeal. In response to the new grounds in the Decision on Appeal, Appellants first rehearing request included copies of references that were not previously of record and suggested remand as an alternative to considering the references. The Panel found itself without jurisdiction to consider the new evidence, but overlooked its authority and responsibility under Rule 41.50(b)(1) to remand the new evidence to the Examiner to consider.

We recognize that even if we are correct that the new grounds in the decision On Request for Reconsideration warrant a second rehearing, this Panel did not invite a second rehearing as is apparently required by Rule 41.52(a)(1). However, we cannot find any decision by any panel that has ever followed that portion of Rule 41.52. Therefore, a waiver of rules under Rule 183 is needed for a second rehearing to proceed.

The suggestion for an expanded panel is to offer the Board a chance to consider how panels should proceed when the examiner's position is too weak to affirm on any basis argued by the examiner. For instance, should oral argument be invited? Should new grounds be identified and supplemental briefing encouraged, before oral argument? Should the panels be encouraged to follow Rule 41.50 and acknowledge their new bases for decision? Should the appellant's options for proceeding be identified explicitly to avoid confusion regarding the expanded options in case of new grounds entered on appeal? Most of these practices have been followed in one case or the other, but none of them were followed here.

Five specific grounds for rehearing are identified in the attached Appeal Second Request for Rehearing. Beyond the general procedural issue, the grounds relate to the corroboration requirement and evidence law, to the requirement for remand when new evidence responds to new grounds on appeal, to addressing the level of ordinary skill in the art, and to whether a 33-word

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passage of a two page article fails to enable the technology disclosed in a 129-page application? *See, Ex parte Jud.*

Contemporaneously with this petition, Applicants are submitting an RCE and asking the Examiner to consider the new evidence, as suggested by the Panel. Appellants request that this petition be granted so that the new evidence will be considered on remand pursuant to Rule 41.50(b)(1), without an RCE. The RCE includes over 200 pages of new evidence, some of which was presented with the first rehearing request. The RCE is necessarily filed in parallel with this petition, because petitions do not suspend other deadlines. A review of the RCE would provide a convincing view of the merits of Appellants' position.

In addition to requesting the second rehearing, Appellants request oral argument. Oral argument was not originally requested because the Examiner's position was not sustainable and Appellants did not foresee the extent to which the declarations would be examined *de novo*. Oral argument in support of the first rehearing was turned down by the Chief Administrative Judge because Appellants did not explain why they had not originally sought oral argument.

Oral argument would be most helpful if an extraordinary second rehearing is allowed, because the panel has raised questions about the evidence and record on appeal in each of its decisions that could have been answered during oral argument, obviating the need for rehearings. The ongoing *de novo* examination can benefit substantially from interaction between counsel and the Panel. Because this application has been on file for nine years, oral argument will be useful to take the panel back to 1998, in the few months immediately after the first standard for XML was published, when these inventors were teaching those of ordinary skill in the art their new interface specification. The risk of hindsight is acute in this case, where the application was filed years ago when something now familiar was at the leading or bleeding edge of software engineering.

Therefore, Appellants respectfully submit this petition for waiver of the rules, pursuant to Rule 183, to allow a second rehearing and oral argument on rehearing. This request is based on the extraordinary circumstances described

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above, with the benefit of understanding the Board's new grounds for decision, which are much different than anything the Examiner argued.

Wherefore, it is requested that the rules be waived and the attached Appeal Second Request for Rehearing be filed and considered by the Panel or an expanded panel; and that oral argument be permitted if any relief other than remand for consideration of new evidence is considered.

Fee Authorization. The Commissioner is hereby authorized to charge the petition fee required under 37 C.F.R. §1.17(f) of \$400 to Deposit Account No. 50-0869 (Atty Docket No. OIN 1004-1).

Conditional Fee Authorization. If this Petition is granted, the Commissioner is hereby authorized to charge the fee required for a request for oral hearing of \$1,000 to Deposit Account No. 50/0869 (Atty Docket No. OIN 1004-1).

Respectfully submitted,

Dated: July 23, 2007


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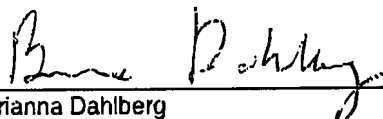
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Commissioner for Patents

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APPEAL REQUEST FOR SECOND REHEARING**AND****SUGGESTION FOR EXPANDED PANEL**

Sir:

This Appeal Request for Second Rehearing under Rule 41.52 is filed in response to the unfavorable decision of August 31, 2006, and denial of relief sought on rehearing dated May 21, 2007. Rehearing is necessary because this appellate Panel entered new grounds after to the first rehearing (Rules 41.50(b), 41.52) in the course of examining the application *de novo*, necessitated by the weakness of the Examiner's

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position. In the original and the first rehearing decision, the new grounds asserted by the Panel have been mistaken and Applicants could not anticipate the mistakes, because they do not repeat any arguments made by the Examiner.

As the Panel did not acknowledge that it was entering new grounds in either of its decisions and neither this Panel nor any decision that we have been able to find invited a second rehearing request, this request is accompanied by a petition to waive the part of Rule 41.52 that requires an invitation to file a second request.

We suggest that an expanded Panel address the procedure for handling cases when the weakness of the Examiner's position prompts the Board to rely on grounds not raised by the Examiner.

Five particular questions for review are presented below, which is a longer list of issues than in the first rehearing request, due to new grounds in the decision On Request for Rehearing and to the recent relevant decisions *KSR International Co. v. Teleflex, Inc.*, 550 U.S., 127 S. Ct. 1727, 167 L. Ed. 2d 705, 82 U.S.P.Q.2D (Apr. 30, 2007) and *Ex parte Jud*, Appeal No. 2006-1061, 2007 Pat. App. LEXIS 9, (BPAI Jan. 30, 2007) (expanded panel, informational opinion).

As there has not been any oral hearing of this matter, this request is also accompanied by a petition for oral hearing so that further misapprehensions of the record on appeal and of the art of record can be avoided. This case is particularly prone to misapprehensions because the Examiner erred badly, the Examiner's brief is difficult to follow, the appeal has strayed far from arguments that the Examiner made and the application is so old that the technology claimed is now familiar.

Should it be determined that any fees are required with regard to the filing of this document, the Commissioner is hereby authorized to charge those fees to Deposit Account No. 50-0869 (OIN 1004-1).

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I. PARTICULAR STATEMENT OF GROUNDS FOR REHEARING

Rehearing, with oral argument, should be granted on the following issues:

1. How should the Board proceed when it finds *de novo* examination necessary, because the Examiner's rejection cannot be sustained on any grounds argued by the Examiner?

2. Whether the Board misunderstood the applicable legal principle when it focused almost exclusively on an exhibit, instead of focusing on the declarations and sufficiency of their corroboration, when those declarations plainly and in detail describe that a registry within the claim language was reduced to practice and performed as intended?

3. Whether the Board overlooked remand under Rule 41.50(b)(1) when it treated publications related to the understanding of those of ordinary skill in the art as new evidence, but did not remand for further examination?

4. Whether the Board overlooked discussing the level of ordinary skill in the art, as required by *KSR* and as informed by *Ex Parte Jud*? Whether applying the correct analysis of the level of ordinary skill, just 33 words¹ in a popular press article disclosed too little to enable the technology described in a 129-page disclosure? And, whether overlooking the level of ordinary skill led the Board to inconsistently demand a high level of specificity from Applicants' Rule 131 witnesses but no specificity at all in McKendrick's 33 words?

5. Whether the Board's conclusion that the reference taught a particular type of data structure specifying an interface including input and output documents misunderstands McKendrick's 33 words?

II. ARGUMENT

We recognize that a second rehearing request is strongly discouraged. To minimize the burden on the Panel, we do not repeat what appeared in the first

¹ "And, because most of these business applications involve manipulation and transfer of data-such as purchase orders, invoices, customer information and appointments XML will allow a rich array of business applications to be implemented." McKendrick, p. 2.

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rehearing request, filed on October 30, 2006. We assume that the reader will make reference to the earlier document, as necessary.

In complete candor, the contemporaneously submitted Request for Continued Examination is accompanied by more than 200 pages of evidence, which the Panel may wait to peruse when dealing whether to remand under Rule 41.50 (b)(1).

A. De Novo Examination Should Include an Invitation from the Panel to Address New Issues in Writing or by Oral Argument

We pointed out in our first rehearing request that the grounds for affirming the Examiner did not repeat any argument made by the Examiner; therefore we invoked Rule 41.50(b) based on the new grounds. Particularly regarding the declarations, the Examiner's primary position was that she had been instructed not to consider the declarations and not to give them any weight. *De novo* examination on appeal was the alternative to remand in these circumstances and held the potential to expedite disposition of this case, if adequate opportunity were given for interaction regarding potential new grounds for rejection. *De novo* examination continued in the decision On Request for Rehearing (May 21, 2007), which features new criticisms and new analysis of the exhibit accompanying our Rule 131 declarations, not aligned with our basis for requesting rehearing.

We suggest that the honorable Board set a policy of informing counsel in advance of new grounds that may be entered on appeal and inviting both additional briefing (§ 41.50(d)) and oral argument. See, e.g., *Ex parte Kraus*, App. No. 2005-0841 (Feb. 22, 2006) (expanded Panel, applicant offered additional oral argument). It is well accepted that interviews are productive for joining and settling issues between applicants and examiners. Some process with the same benefits as an interview should be followed when the Panel cannot endorse any arguments made by the examiner -- finding the allowable subject matter in an application should be a cooperative process.

We also suggest consistent use of the "Options for Further Proceedings" section that has appeared in some recent opinions. *Id.*

B. The Panel Misapprehended the Limited Corroboration Required by Rule 131 when it Scrutinized Exhibit A Instead of Beginning with the Declarations

The Panel very carefully discussed technical activities 1-6 listed in Exhibit A in the decision On Request for Rehearing, at pp. 2-5. As the Panel's analysis of Exhibit A

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does not repeat any argument that the Examiner made, or any grounds from the original Decision on Appeal and does not respond directly to our first request for reconsideration, Rule 41.50(b) should apply and this decision should not be considered final for purposes of judicial review. See, e.g., *Ex Parte Liebermann*, App. No. 2007-0012, § IV.(C)(6) (Bd. Pat. App. & Inter. May 17, 2007) (new grounds acknowledged by Panel). Focusing so sharply on Exhibit A misapprehends the law, as Rule 131 allows Applicants to swear behind a reference without exhibits.

The PTO instructs examiners, in MPEP § 715.07, at 700-251 (Rev. 2, May 2004), that corroborative documents need not be presented, at all. "[I]n interference practice, conception, reasonable diligence, and reduction to practice require corroboration, whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects. *Ex parte Hook*, 102 U.S.P.Q. 130 (Bd. App. 1953)." This is consistent with Rule 131(b), which accepts an explanation for the absence of supporting documents, and thereby permits declarations to stand on their own without corroboration.

The cases that the Panel cites, *In re Scheiber*, 587 F.2d 59, 62 n. 6, 199 U.S.P.Q. 782 (CCPA 1978) ("expressing views" re Rule 131); *In re Stempel*, 44 CCPA 820, 241 F.2d 755, 113 USPQ 77 (CCPA 1957) (chemical arts, genus claim) and *In re Tanczyn*, 52 CCPA 1630, 347 F.2d 830, 146 USPQ 298 (CCPA 1965) (chemical composition claim) do not require any documentary corroboration. Of course, the cases cannot require more than Rule 131, which permits declarations without corroboration, upon appropriate explanation.

In this case, the declarations only need to show reduction to practice a few weeks before this patent application was filed, because the September 1998 reference date is not much earlier than the October 18, 1998 filing date, or show diligence for a few weeks preceding filing of a 129-page application.

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The declarations were clearly worded and directly to the point², but were not considered by the Panel on rehearing as a primary basis for removing the reference. We explained how Commerce One's bankruptcy limits access to better corroboration, following purchase of these applications in a bankruptcy sale. The inventors unequivocally declared that a registry was implemented and employed in a method and form sufficient to demonstrate that the method worked for its intended purpose. Nonetheless, the Panel, at p. 3, concluded that no evidence had been provided that planned activities actually occurred. Through page 3, where the Panel announced its decision, the declarations had been entirely overlooked — not even mentioned. Moreover, the Panel continues to overlook the passage of Exhibit A which declaration ¶ 4 quotes.

The correct legal analysis begins with the inventors' testimony, not the exhibit. We explained in our first request, pp. 4-10, 15-19, why the testimony in the declarations is detailed and sufficient. It is not enough for the Panel to say, at pp. 4-5, "Applicants' Declaration fails to make up for the deficiencies of Exhibit A." The Panel on rehearing has overlooked the legal rule that the declarations by themselves can be sufficient to

² We discussed the level of detail in and meaning of the declaration testimony in our first request for reconsideration and do not repeat that here. For reference, the testimony was:

"3. Prior to March 11, 1998, we had implemented a registry for trading partners. The registry was used in a method, also implemented prior to March 11, 1998, in a form sufficient to demonstrate that the method would work for its intended purpose, for establishing transactions among trading partners in a network, comprising: maintaining a registry of machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners; and providing, in response to a request, one or more of the machine-readable specifications from said registry is via a communication network to a requesting node.

"4. Attached hereto as Exhibit A is an excerpt of a memorandum, which I am informed, or know from personal knowledge, was written by co-inventor Glushko, prior to March 11, 1998. Exhibit A includes the statement, 'In particular, the eCo server has now subsumed the registry and query services that had been envisioned as part of the Taxonomy of Everything in our proposal.' This comment establishes that the registry and supporting services had been implemented at the time the memorandum was written."

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remove McKendrick as a reference and the fact that the declarations describe more than the McKendrick reference does.

C. The Board Should have Remanded to the Examiner Pursuant to Rule 41.50(b)(1) if it Considered Material in the First Rehearing Request to be New Evidence

In the first rehearing request, we discussed at length (pp. 2-11 and 14-15) how one of skill in the art would understand the declarations and the inventors' activities. The Panel considered our presentation to go beyond the record³ and to be a submission of new evidence.

Rule 41.50(b)(1) says that when new evidence is submitted in a rehearing request, the Board will remand for initial consideration by the examiner. We suggested remand at pp. 8-9 of our first request, if needed for the evidence to be considered. The Panel considered what we presented to be new evidence⁴, but overlooked the directive of Rule 41.50(b)(1) to remand for initial consideration by the Examiner.

Remand is important, because additional evidence is considered before the Panel's decision becomes final for purposes of appeal to the Federal Circuit. Rule 41.50(b)(1). Remand of this appeal could be combined with the contemporaneously filed RCE, for compactness of prosecution.

Applicants respectfully request remand, if the Panel is not persuaded that the declarations are sufficient to remove McKendrick as a reference.

³ To remind the Panel how far the colloquy on appeal has diverged from the Examiner's position during prosecution, we recall that the original Examiner's Answer Brief, at 3-4 (Aug. 24, 2005) insisted on filing of a Rule 47 petition, which applies only to oaths submitted with patent applications. *Compare*, supplemental Examiner's Answer, at 1 (Sept. 22, 2005) (explaining supplemental submission). The supplemental Examiner's Answer insisted that only the Office of Petitions could consider declarations by fewer than all of the named inventors. *Id.* at 15-16. The Examiner misunderstood "corroboration" as calling for "independent witnesses." *Id.* at 17. In the interest of compact prosecution, the Examiner's penultimate conclusion, at 19, was that Exhibit A "did not constitute an actual reduction to practice", apparently because it was not a program, and did not "constitute a constructive reduction to practice" because it was not a US patent application. This passage is cited in the decision On Request for Rehearing, at 2 (middle of the page), but was not a rationale that the Panel could endorse or that the Panel adopted.

⁴ The decision, at 7, quotes the cross reference to Rule 41.52(a)(3) which leads to Rule 41.50(b) and remand. However, the chain of references was overlooked.

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D. The Board Should have Considered the Level of Ordinary Skill in the Art

The material that the Panel considered to be new evidence was relevant to the level of ordinary skill in the art. The importance of this factor was re-emphasized by the Supreme Court and by the BPAI after we filed our request for rehearing. *KSR v. Teleflex*, 550 U.S., 127 S. Ct. 1727; 167 L. Ed. 2d 705; 82 U.S.P.Q.2D (Apr. 30, 2007); *Ex parte Jud*, Appeal No. 2006-1061, 2007 Pat. App. LEXIS 9, (BPAI Jan. 30, 2007) (expanded panel, informational opinion). (Applicants diligently consulted with Mr. Craig Fineberg regarding how the new decisions would be taken into account while our first request for reconsideration was pending.)

There is no discussion by the Panel in its original decision or On Request for Rehearing of the level of ordinary skill in the art, in either the context of the declarations or reading the McKendrick reference. The only discussion in the original decision of the level of ordinary skill was that the W3C XML language description was widely known (at 15-16), but that language description says nothing about interfaces or interface specification data structures. The level of ordinary skill regarding architectures for useful application of XML was not discussed by the Panel.⁵

Additional references have been submitted with the RCE and hereby incorporated by reference.

The level of ordinary skill needs to be considered, because it affords a neutral standard for evaluating three competing technology descriptions: the 129-page patent application, the two paragraphs of declaration testimony corroborated by a passage of Exhibit A that the Panel has not yet discussed, and the 33 words in McKendrick. For instance, the discussion of skill in the art found in *Ex parte Jud*, § B.1 at 4-5, implies that a subject to which Applicants devote 129 pages of explanation cannot be rendered obvious in 33 words.

The level of ordinary skill is especially important when the Panel does not understand why (p. 5) the registry accessible to many, which these inventors reduced to practice, was within claim wording that calls for a data structure stored in memory accessible to at least one node.

⁵ Additional references have been submitted with the RCE and are hereby incorporated by reference.

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We suggest that further consideration be given to the level of ordinary skill by the Panel or on remand, consistent with the recent relevant decisions. Rule 41.52(a)(2).

E. The 33 Words of McKendrick's Popular Press Article have been Misunderstood

The 33 words from McKendrick, which the Examiner considered to render obvious claims that concluded a 129-page application, are:

And, because most of these business applications involve manipulation and transfer of data-such as purchase orders, invoices, customer information and appointments XML will allow a rich array of business applications to be implemented.

McKendrick, p. 2. This passage does not reveal anything about how much progress had been made by September 1998 toward implementing systems using XML or what software architectures were being considered. The Panel's original Decision on Appeal, at 8, specifically states that "mere use of XML does not disclose input and output documents, per se." It follows that projected future of XML mentioned in McKendrick does not disclose a machine readable interface specification to a transaction process including both input and output documents, either. If the Panel considers Exhibit A merely to foretell future development work, it should apply the same degree of skepticism to McKendrick, which is much briefer and vaguer. In our first request for reconsideration, we presented a range of interpretations to McKendrick that would not read on the claims.⁶

Without remand, the Panel could determine that McKendrick says too little expressly and implies nothing inherently that would render obvious the claim:

*1. An interface for transactions among nodes in a network including a plurality of nodes which execute processes involved in the transactions, the interface being stored in a computer readable medium, comprising:
a machine readable specification of an interface to transaction processes stored in memory accessible by at least one node in the network, including interpretation information providing a definition of an input document, and a definition of an output document, the definitions of the input and output documents comprising respective*

⁶ In the contemporaneous RCE, we submit several documents that contradict the Panel's interpretation of McKendrick and of where Microsoft was leading those of ordinary skill.

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descriptions of sets of storage units and logical structures for the sets of storage units.

We respectfully request that the Panel reverse its position regarding McKendrick. Alternatively, the Examiner would be directed to further consider McKendrick in view of the level of ordinary skill in the art, on remand, especially taking into account *Ex parte Jud*.

III. CONCLUSION

In view of the foregoing, Appellants ask that this honorable Board reconsider its decision and reverse the Examiner's rejections of the claims or, alternatively, remand for further examination and consideration of new evidence submitted with the first request for reconsideration.

Respectfully submitted,

Dated: 23 July 2007

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